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JUN 11 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicant(s): Sadelain et al.

Application No.: 08/940,544

Filed: 9/30/1997

Title: Fusion Proteins of a Single Chain
Antibody and CD28, and Uses Thereof

Attorney Docket No.: MSK.P-035

Group Art Unit:
1642Examiner:
Larry Ronald Helms

Confirmation No.: 5042

REPLY BRIEF FOR APPELLANT

This Reply Brief is filed in support of Applicants' Appeal from the rejection mailed 6/18/2003, and in response to the Examiner's Answer mailed April 13, 2004.

As noted in Applicants opening Brief, a new issue is presented for consideration in this case, namely whether a reference alleged to be anticipatory must provide a written description of the invention. Regrettably, the Examiner has elected to not address this issue, either by providing arguments that the law does not require the reference to provide a written description, or by arguing that the references do in fact meet this standard. Indeed, the Examiner has merely stated that in response "the response to the enablement issue is restated." The Examiner also directs Appellants to MPEP 2132.01. However, this section of the MPEP relates only to the anticipatory affects of genus and species disclosures, and not to the quality of disclosure required.

I hereby certify that this paper and any attachments named herein are transmitted to the United States Patent and Trademark Office, Fax number: 703-872-9306 on June 11, 2004


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June 11, 2004
Date of Signature

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The case law now extant makes it clear that enablement and written description are distinct requirements of 35 USC § 112, first paragraph. The Examiner has failed to create a clear record as to the reasons why, either as a matter of fact or law, these same requirements should not be applied to an allegedly anticipatory reference. Accordingly, Applicants submit that involvement of the Office of the Solicitor to adduce an Office Policy or position on this issue prior to determination by the Board of Appeals would facilitate the decision.

Respectfully submitted,



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